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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/050,680

Filing Date: January 15, 2002

Appellant(s): PECORINI ET AL.

MAILED
FEB 26 2007
GROUP 1700

James W. Proscia
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 11/13/06 appealing from the Office action mailed

1/6/06.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

EP 370424 B1	AKAO	5-1990
JP 54129050 A	TANAKA et al.	10-1979

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 10-11, 13-15, and 18-25 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 54129050.

Using English translation of JP 54129050 provided by applicants, it is noted that JP 54129050 discloses coloring masterbatch, i.e. concentrate, for polyester wherein the masterbatch comprises pigment and 12-58% ethylene-ethyl acrylate copolymer. The copolymer contains 5-30% ethyl acrylate and 60-95% ethylene. There is no disclosure of low melt viscosity resin. There is also disclosed method of preparing polyester composition comprising adding the above masterbatch to polyester. The masterbatch is present in the polyester composition in amount of, for instance, 1.8% as calculated from application example 1. It is further disclosed that the polyester composition is used to make molded article (claims, page 4, 1st full paragraph – page 5, 3rd full paragraph, and application examples 1 and 2). Given that JP 54129050 discloses polyester composition identical to that presently claimed, i.e. prepared from identical color

masterbatch, i.e. concentrate, and polyester, it is clear that the composition would inherently possess same inherent viscosity and moisture content as presently claimed.

In light of the above, it is clear that JP 54129050 anticipates the present claims.

2. Claims 1, 3, 10-11, 13, 18-22, and 24-25 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 370424.

EP 370424 discloses masterbatch, i.e. concentrate, for polyester wherein the masterbatch comprises 5-70% carbon black and 5-90% modified polyolefin such as ethylene-methyl acrylate copolymer or ethylene-ethyl acrylate copolymer wherein the copolymers comprise 0.01-5% alkyl acrylate and 95-99.5% ethylene. There is also disclosed method of preparing polyester composition comprising adding the above masterbatch to polyester. It is further disclosed that the polyester composition is used to make molded article. While EP 370424 discloses the use of polyolefin wax, i.e. low melt viscosity resin, it is noted that the polyolefin wax is not required in the composition, i.e. present in amount of less than 70 wt.% (col.2, lines 34-37 and 43-58, col.3, lines 9-11, 20-22, 24-26, and 38-42, col.5, line 41, col.6, lines 25-30, and col.col.7, line 54-col.8, line 5). Given that EP 370424 discloses polyester composition identical to that presently claimed, i.e. prepared from identical color masterbatch, i.e. concentrate, and polyester, it is clear that the composition would inherently possess same inherent viscosity and moisture content as presently claimed.

In light of the above, it is clear that EP 370424 anticipates the present claims.

3. Claims 1, 3-5, 7, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 54129050 in view of EP 370424.

Using English translation of JP 54129050 provided by applicants, it is noted that JP 54129050 discloses coloring masterbatch, i.e. concentrate, for polyester wherein the masterbatch comprises pigment and 12-58% ethylene-ethyl acrylate copolymer. The copolymer contains 5-30% ethyl acrylate and 60-95% ethylene. There is no disclosure of low melt viscosity resin. There is also disclosed method of preparing polyester composition comprising adding the above masterbatch to polyester. The masterbatch is present in the polyester composition in amount of, for instance, 1.8% as calculated from example 1. It is further disclosed that the polyester composition is used to make molded article (claims, page 4, 1st full paragraph – page 5, 3rd full paragraph, and application examples 1 and 2).

The difference between JP 54129050 and the present claimed invention is the requirement in the claims of specific olefin/acrylate copolymer.

JP 54129050 discloses the use of ethylene-ethyl acrylate copolymer.

EP 370424, which is drawn to masterbatch for polyester as is JP 54129050, discloses the use of ethylene-methyl acrylate copolymer in order to produce polyester composition that has no light-shielding or appearance problems. Further, EP 370424 discloses the equivalence and interchangeability of ethylene-ethyl acrylate as disclosed by JP 54129050 and ethylene-methyl acrylate as presently claimed (col.2, lines 32-39 and col.3, lines 9-10).

Given that JP 54129050 in view of EP 370424 discloses polyester composition identical to that presently claimed, i.e. prepared from identical color masterbatch, i.e. concentrate, and

polyester, it is clear that the composition would intrinsically possess same inherent viscosity and moisture content as presently claimed.

In light of the above, it therefore would have been obvious to one of ordinary skill in the art to use ethylene-methyl acrylate as the copolymer in JP 54129050 in order to produce masterbatch that imparts good light shielding and appearance to polyester composition, and thereby arrive at the claimed invention.

4. Claims 4-5, 7, 9, 14-15, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 370424.

The disclosure with respect to EP 370424 in paragraph 2 above is incorporated here by reference.

The difference between EP 370424 and the present claimed invention is the requirement in the claims of the amount of the masterbatch or concentrate in the polyester composition.

There is no explicit disclosure in EP 370424 of the amount of masterbatch present in the polyester composition.

However, col.2, lines 36-39 of EP 37424 discloses adding masterbatch to base resin, i.e. polyester, in order to prevent light shielding trouble and appearance trouble such as irregular color and weld lines. In light of this disclosure, it would have been within the skill level of one of ordinary skill in the art to choose amount of masterbatch necessary to prevent light shielding and appearance troubles in polyester composition.

In light of the above, it therefore would have been obvious to one of ordinary skill in the art to choose amount of masterbatch or concentrate utilized in the polyester composition,

including that presently claimed, in order to prevent light shielding trouble and appearance trouble, and thereby arrive at the claimed invention.

(10) Response to Argument

It is noted that appellants arguments with respect to both the 35 USC 102 and 35 USC 103 rejections of record are the same, namely that none of the cited prior art of record, either alone or in combination, discloses moisture content as presently claimed. Thus, it is noted that appellants' arguments and examiner response set forth below with respect to the 35 USC 102 rejections of record utilizing JP 54129060 and EP 374050 are also applicable to the 35 USC 103 rejection of record utilizing JP 54129050 in combination with EP 370424.

Appellants argue, and the examiner agrees, that there is no explicit disclosure in JP 54129050 or EP 370424 of moisture content as required in all the present claims.

However, given that JP 54129050 and EP 370424 each disclose concentrate identical to that presently claimed, i.e. comprising colorant and copolymer obtained from the same type and amount of monomer as presently claimed, wherein the concentrate is added to polyester composition to produce colored polyester composition as presently claimed, it is the examiner's position that the concentrate of EP 370424 would inherently provide polyester composition with moisture content as presently claimed (claim 1) and that the polyester composition of either JP 54129050 or EP 370424 would inherently possess moisture content as presently claimed (claims 10, 19, and 21).

Applicants argue that application of inherency to imply a specific moisture content is inappropriate given that moisture in a composition can take on any value.

However, while appellants argue that the moisture content of a composition can take on any value, appellants have offered no evidence to support this position specifically with respect to the presently claimed polyester composition.

It is the examiner's position that moisture content is inherent to the presently claimed polyester composition. Evidence to support this position is found in present claim 1, for instance, which recites that the concentrate "provides a polyester composition having a moisture content of less than about 0.1 wt%" when the concentrate is combined with a base polyester. Thus, it is clear that the concentrate determines the moisture content of the polyester composition. Further evidence to support this position is found in appellants' specification where Table 1 shows that the moisture content is dependent on the color concentrate utilized in the polyester composition. Thus, it is the examiner's position that the moisture content of the polyester composition does depend on the color concentrate utilized.

Appellants argue that the examiner has misinterpreted the use of the word "when" in claim 1. However, the portion of claim 1 cited by the examiner as evidence refers to the phrase "provides a polyester composition having a moisture content of less than about 0.1 wt%". That is, this portion of claim 1 states that it is in fact the concentrate that "provides" a polyester composition having moisture content less than about 0.1 wt.%.

Appellants also argue that the examiner has misinterpreted Table 1 of the specification given that a number of the comparative additives are not concentrates *per se* but are merely color additives.

While appellants have not clarified which of the comparative examples cited in Table 1 utilize additives and not concentrates, it is significant to note that page 15, lines 13-14 of the present specification recite that the data of Table 1 “show materials made according to the present invention contain less moisture than other polyester colored with other colorant methods”. Thus, given that JP 54129050 and EP 370424 each disclose polyester combined with concentrate as presently claimed and not “other colorant methods”, it is the examiner’s position that the polyester composition of each of JP 54129050 and EP 370424 would inherently possess moisture content as presently claimed. That is, given that JP 54129050 and EP 370424 disclose polyester composition made “according to the present invention”, i.e. adding concentrate comprising colorant and olefin/acrylate copolymer or olefin/methacrylate copolymer to polyester composition, and absent evidence to the contrary, it is the examiner’s position that the polyester composition of JP 54129050 or EP 370424 would inherently possess moisture content as presently claimed.

Appellants also argue that the composition of the present invention is a mixture which is dependent on the substitute ingredients and the concentrations of these ingredients. Further, appellants argue that the moisture content can take any value which can be adjusted by the moisture content of the ingredients used, by combining under humid conditions, by intentionally pouring water in, etc.

However, JP 54129050 and EP 370424 each disclose concentrate as presently claimed that is added to polyester composition as presently claimed. Attention is drawn to MPEP 2112.01, which states that “products of identical chemical composition can not have mutually exclusive properties.. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present”, *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Further, given that JP 54129050 and EP 370424 each disclose color concentrate and polyester identical to that presently claimed, it is clear that one skilled in the art viewing either JP 54129050 or EP 370424 would understand that the unmentioned feature, i.e. moisture content, is necessarily present in each of the references.

It is further noted that JP 54129050 does not require the use of any ingredients other than those explicitly claimed. While the composition of EP 370424 includes additional ingredients, firstly, it is noted that in light of the open language of the present claims with respect to the concentrate and the polyester composition, i.e. “comprising”, such ingredients are clearly not excluded from the scope of the present invention. Further, appellants have provided no evidence that any additional ingredients disclosed by EP 370424 would affect the moisture content.

While appellants argue that the moisture content of the polyester composition can be can be adjusted by the moisture content of the ingredients used, by combining under humid conditions, by intentionally pouring water in, etc., appellants have provided no evidence to support this position. It is noted that Table 1 of the present specification, which discloses that the moisture content of the polyester composition comprising the presently claimed concentrate is less than that of other polyester compositions that do not contain the presently claimed

concentrate, does not disclose that the moisture content of the composition was adjusted in any other way, i.e. by combining under humid conditions, by intentionally pouring water in, etc., other than adding the color concentrate to the polyester.

Further, it is significant to note that there is nothing in the present claims that requires adjusting the moisture content of the polyester composition. That is, there is no requirement in any of the present claims regarding how the moisture content is achieved other than by adding color concentrate to polyester composition. Claims 10 and 19 each only require adding the color concentrate to polyester composition which is disclosed by both JP 54129050 and EP 370424 while claim 21 only requires polyester composition comprising polyester and the concentrate which is disclosed by both JP 541290 and EP 370424. With respect to claim 1, it is noted that this claim is drawn to a concentrate that “provides a polyester composition having a moisture content of less than about 0.1 wt%” when added to polyester composition. Given that EP 370424 (and the combination of JP 54129050 in combination with EP 370424) disclose concentrate as presently claimed, and absent evidence to the contrary, it is clear that such concentrate would inherently (intrinsically) provide polyester composition with moisture content as presently claimed.

In conclusion, while it is agreed that there is no explicit disclosure in JP 54129050 or EP 370424 regarding moisture concentrate, it is significant to note that each of JP 54129050 and EP 370424 disclose concentrate identical to that presently claimed, i.e. comprising colorant and copolymer obtained from the same type and amount of monomer as presently claimed, wherein the concentrate is added to polyester composition to produce colored polyester composition as

presently claimed. In light of this, given that claim 1 recites that it is the concentrate that “provides” polyester composition with moisture content less than 0.1 wt.%, and given that Table 1 of the present specification discloses that polyester composition without presently claimed concentrate does not have moisture content as presently claimed, it is the examiner’s position that JP 54129050 and EP 370424 inherently disclose moisture content as presently claimed.

As set forth in MPEP 2112 V., once a reference teaching a product appearing to be substantially identical is made the basis of a rejections and the examiner present evidence or reasoning tending to show inherency, the burden shifts to the applicant to show an unobvious difference. It is noted that “the PTO can require an applicant to provide that the prior art products do not necessarily or inherently possess the characteristics of his [or her] claimed product. Whether the rejection is based on inherency under 35 USC 102, on *prima facie* obviousness under 35 USC 103, jointly or alternatively, the burden of proof is the same....”, *In re Fitzgerald*, 619 F.2d 67, 70, 2054 USPQ 594, 596 (CCPA 1980).

While appellants argue that moisture content of the polyester composition can take on any value and that the moisture content can take any value which can be adjusted by the moisture content of the ingredients used, by combining under humid conditions, by intentionally adding water in, etc., appellants have provided no evidence to support their position and no evidence that the concentrate of EP 370424 or JP 54129050 in combination with EP 37024 does not provide polyester composition with moisture content as presently claimed or that the polyester composition of JP 54129050 or EP 370424 does not possess moisture content as presently claimed.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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2/15/07

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